REMARKS

Claims 1-20 will be pending upon entry of the present amendment. Claims 1-10 are amended and claims 11-20 are new. No new matter is being added. The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Objections

1.   Claims 1, 6-10

Claims 1, 6-10 were objected to for having informalities. Applicants believe that claims 1 and 6-10 have been amended to correct the informalities. Therefore Applicants request that the objection be withdrawn.

2.   Claim 8

Claim 8 is objected to under 37 CFR 1.75(c) for allegedly failing to further limit the subject matter of the previous claim. In particular, it was stated in the Office Action that the limitation "individual mobile terminal specific data will be stored during manufacture in the second memory," recited in claim 8, which indirectly depends from claim 1, removed a limitation ("individual mobile terminal specific data are stored in the second memory device after manufacturing of the mobile terminal") from claim 1. Applicants have amended claim 1 to recite, *inter alia*, " ... individual mobile terminal specific data are stored in the second memory device after the mobile terminal is operatively functional ... ." Applicant respectfully submits that amended claim 8 further limits amended claim 1, and therefore Applicants respectfully request that this objection be withdrawn.

Rejections Under 35 U.S.C. § 102

Claims 1, 2 and 10 stand rejected under 35 U.S.C. § 102(b) as being allegedly being anticipated by publication WO 01/89245 to Domokos et al. (hereinafter "Domokos").

Amended claim 1 recites, *inter alia*, "a SIM card ... including a second memory device ... has *stored therein* individual mobile terminal specific data that includes *individual mobile terminal calibration values specific to at least one part of the mobile terminal that is exterior to the SIM card*, ... and wherein individual mobile terminal calibration values include *at least one individual correction setting of the at least one part* of the individual mobile terminal that is that is *exterior to the SIM card*." (Emphasis added.)

In other words, a setting that calibrates a part, which is external of the SIM card, is stored in the memory of the SIM card. The aforementioned limitation is similar to a limitation in original claim 5, and consequently, the subject matter of the rejection of claim 5 is discussed below. At page 4 of the Office Action, it is alleged that Domokos page 4, lines 11-23, page 7, lines 13-24, and page 8, lines 12-22, discloses that "the individual mobile terminal specific data include calibration values, correction settings of high frequency parts of the mobile terminal or default values." The aforementioned cited portions of Domokos discuss SIM cards with filtering modules. Domokos fails to discuss the memory of the SIM card storing settings (which are specific to the mobile terminal) that calibrate a part that is external to the SIM card. Applicants submit that there is no apparent reason for believing that the memory of the SIM card would store calibration settings which are specific to the mobile terminal for parts of a mobile handset (mobile terminal) that are external to the SIM card. Domokos discusses switching different SIM cards in and out of the mobile handset (mobile terminal) as needed (page 4, lines 17-23). Applicants respectfully submit that Domokos would not store calibrations settings (which are specific to the mobile terminal) for parts that are external to the SIM card because the SIM cards are intended to be interchangeable/replaceable. Therefore, Applicants respectfully request that the rejection of claim 1 be withdrawn.

Amended claim 10 recites a similar, but not identical, limitation. In particular, claim 10 recites, *inter alia*, "*storing* individual mobile terminal specific data *in a second memory device of a first SIM card*, the individual mobile terminal specific data *including the at least one individual mobile terminal calibration value*." (Emphasis added.) Applicants respectfully submit that Domokos fails to disclose at least the aforementioned limitation. Therefore, Applicants respectfully request that the rejection of claim 10 be withdrawn.

Rejections Under 35 U.S.C. § 103

It is well-established law that, for a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references ***must*** disclose, teach, or suggest, ***either implicitly or explicitly, all elements/features/steps of the claim at issue***. *See, e.g., In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) (emphasis added) , and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). *Glaverbel S.A. v. Northlake Mkt'g & Supp., Inc.,* 45 F.3d 1550, 33 USPQ 2d 1496 (Fed. Cir. 1995) ("the claimed process, including each step thereof, must have been described or embodied, either expressly or inherently.") To establish *prima facie* obviousness of a claimed invention, **all the claim limitations must be taught or suggested** by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

1.   Domokos: Claims 3, 5, 6, and 9

Claims 3, 5-6 and 9 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Domokos.

a.   Official Notice Not Taken

The rejections of claims 3, 5, 6, and 9 fail to recite a single other reference and there is no taking of Official Notice. Consequently because Official Notice has not been taken, there is no Official Notice for Applicants traverse. Applicants reserve their right to traverse a taking of Official Notice in a subsequent Office Action, if any, under MPEP 2144.03.C.

b.   No Prima Facie Case: Claim Limitations Not Explicitly Or Inherently
     Disclosed

Claim 3:

The Office Action cites page 5, lines 2-6, for allegedly disclosing the limitation of the "terminal independent data [is] stored in the first memory device will never be changed during the lifetime of the mobile terminal."

Domokos explicitly states at page 5, lines 2-4, "the size of the communications terminal can be kept to a minimum, because *hardware specific* to supporting standards which are not required by the user *is not incorporated into the communications terminal* (emphasis added)." There is no reason to believe that any memory of Domokos stores data for hardware that is not incorporated into the mobile terminal.

Domokos explicitly states at page 5, lines 5-6, "the design of the transceiver hardware for the communications terminal becomes common, thereby reducing manufacturing costs." There is no disclosure, teaching, or suggestion to believe that "common" transceiver hardware supporting "voice/audio coder/decoder" will have data stored in a memory that will never be changed. Domokos teaches against doing that because Domokos is directed to "[a]daptive terminals [that] have hardware which is reconfigurable by means of a standardised software download method" (page 1, paragraph 4).

It is asserted in the Office Action that Domokos "implicitly" discloses the aforementioned limitation. The assertion of an "implicit" disclosure is an admission that Domokos does not "explicitly" disclose the same.

The Examiner has a high burden for establishing inherency:

> The fact that a certain result or characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Inherency*, however, *may not be established by probabilities or possibilities*. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

MPEP § 2112.IV (underlined italicized emphasis added).

The mere possibility that Domokos may "implicitly" disclose the aforementioned limitation is insufficient for establishing inherency. *In re Robertson, supra.*

For at least the reasons provided above, the Office Action has failed to establish a *prima facie* case of obviousness, and therefore, Applicants request that the rejection of claim 3 be withdrawn.

<u>Claim 5</u>

Amended claim 5 recites, *inter alia*, "at least one high frequency part that is *external to the SIM card*, and wherein the individual mobile terminal calibration values includes at least one calibration value for a respective setting of at the least one high frequency part of the mobile terminal." Domokos discusses filters being a part of a SIM card so that the filters can be switched by switching SIM cards and fails to disclose, teach, or suggest a "high frequency part that is external to the SIM card." Therefore, Domokos fails to disclose storing a calibration setting for such a high frequency part in a memory of a SIM. Consequently, Applicants respectfully request that the rejection of claim 5 be withdrawn.

Further, it is asserted in the Office Action that Domokos "would obviously, if not implicitly" include calibration data for filters. Domokos fails to explicitly disclose, teach or suggest the memory of the SIM storing calibration data for filters, which Applicants submit is the reason that it is argued that it is "implicitly" disclosed. The Examiner has failed to meet his burden for showing that Domokos "inherently" discloses the limitations of claim 5. See *In re Robertson, supra* ("*Inherency*, however, *may not be established by probabilities or possibilities*. The mere fact that a certain thing may result from a given set of circumstances is not sufficient'"). Therefore, the Office Action has failed to establish a *prima facie* case of obviousness, and Applicants respectfully request that the rejection of claim 5 be withdrawn.

<u>Claim 9</u>

Amended claim 9 recites, *inter alia*, that "*all fixed operating data* for operating the mobile terminal *is stored in the second memory*." (Emphasis added.) Domokos discusses switching different SIM cards in and out of the mobile handset (mobile terminal) as needed (page 4, lines 17-23). Applicants respectfully submit that Domokos would not store *all fixed operating data* for operating the mobile terminal in the memory of the SIM card because the SIM cards are intended to be interchangeable/replaceable. Therefore, Applicants respectfully request that the rejection of claim 9 be withdrawn.

2.   Molne: Claims 1, 2, 5, 6, 9 and 10

Claims 1, 2, 5, 6 and 10 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6, 014,561 to Molne, and claim 9 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Molne in view of U.S. Patent No. 5,915,226 to Martineau.

a.   Amended Independent Claims 1 And 10

As previously discussed above, amended claim 1 recites, *inter alia*, "a SIM card … including a second memory device … has *stored therein* individual mobile terminal specific data that includes *individual mobile terminal calibration values specific to at least one part of the mobile terminal that is exterior to the SIM card*, … and wherein individual mobile terminal calibration values include *at least one individual correction setting of the at least one part* of the individual mobile terminal that is that is *exterior to the SIM card*" (emphasis added), and amended claim 10 includes a similar, but not identical, limitations.

Molne fails to disclose, teach, or suggest at least the aforementioned limitations. Therefore, Applicants respectfully request that the rejection of claim 10 be withdrawn.

b.   Official Notice Not Taken

The rejections of claims 1, 3, 2, 5, 6 and 10 fail to recite a single other reference and there is no taking of Official Notice. Consequently because Official Notice has not been taken, there is no Official Notice for Applicants traverse. Applicants reserve their right to traverse a taking of Official Notice in a subsequent Office Action, if any, under MPEP 2144.03.C.

c.   Claim 9

At pages 7 and 8 of the Office Action, the rejection of claim 9 states that "since Molne is silent with a removable SIM card, Molne would obviously suggest the SIM card is permanently attached in the handset." Applicants have amended claim 9 to clarify that "fixed

data" for operating the mobile terminal is stored in the second memory device. In other words, claim 9 does not recite that the SIM is fixed.

New Claims 11-20

Newly added claims 11-13 depend from amended independent claim 10 and provide further limitations thereof.

Newly added claim 14 depends from claim 4, and newly added claim 15 depends from claim 14. Claim 14 further limits claim 4 by reciting "the mobile terminal is _fully functionally operable_ in a post manufacturing state _with only the first memory device and the second memory_ and _does not require any other memory device_ to fully operate after manufacturing." (Emphasis added.)

Claim 15 further limits claim 14 by reciting that "the mobile terminal includes the first memory device and the second memory device _and no other memory device_." (Emphasis added.)

Independent claim 16 and its dependent claims 17-20 have been added. Claim 16 recites, _inter alia_, "a first memory device that is one of _a read only memory (ROM) or as a Flash memory_ and that has terminal independent data including at least _an operation system and start-up sequences stored therein_, wherein terminal independent data are stored therein during manufacturing of the mobile terminal, and wherein the first memory device is electrically connected to the first processing unit." (Emphasis added.)

Conclusion

Overall, the cited references do not singly, or in any motivated combination, teach or suggest the claimed features of the embodiments recited in independent claims 1, 10 and 16 and thus such claims are allowable. The remaining claims depend from allowable independent claims 1, 10 and 16, and also include additional limitations; consequently, such claims are likewise allowable. If the undersigned attorney has overlooked a relevant teaching in any of the references, the Examiner is requested to point out specifically where such teaching may be found.

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In light of the above amendments and remarks, Applicants respectfully submit that all pending claims are allowable. Applicants, therefore, respectfully request that the Examiner reconsider this application and timely allow all pending claims. Examiner Nguyen is encouraged to contact Mr. Ringer by telephone to discuss the above and any other distinctions between the claims and the applied references, if desired. If the Examiner notes any informalities in the claims, he is encouraged to contact Mr. Ringer by telephone to expediently correct such informalities. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

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